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TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

EXAMINER
BROWN, RUEBEN M

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/690,549
Filing Date: October 17, 2000
Appellant(s): RASHKOVSKIY, OLEG B.

Timothy Trop
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/16/2009 appealing from the Office action

mailed 9/26/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Appeal No. 2007-0721, decided March 7, 2008 for this application.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in

the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,434,747	KHOO	8-2002
6,446,261	ROSSER	9-2002
5,233,423	JERNIGAN	8-1993
5,790,935	PAYTON	8-1998
2004/0111317	EBISAWA	6-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

2.   Claims 47-50 & 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khoo,

(U.S. Pat # 6,434,747), in view of Rosser, (U.S. Pat # 6,446,261) and Jernigan, (U.S. Pat #

5,233,423).

Considering claim 47, the claimed *'receiver to receive content, an advertisement'*, reads

on the client 235, which receives and stores content media & advertising media, see Khoo; col. 5,

lines 29-42; col. 6, lines 52-65 & Fig. 3. Khoo also more specifically teaches that client 235

comprises a Media Cache Service Module 410 that stores the content media and advertising,

which are generated by server 225 and transmitted by the instant server 225 to the client 235;

also see col. 8, lines 6-67 & Fig. 4.

'a cache, coupled to the receiver, to store the content and the advertisement', is met by

the Media Cache Service Module 410 of Khoo, which stores audio/video data, including

advertisements, col. 8, lines 6-67; col. 10, lines 41-67 & Fig. 4.

As for the claimed, *'update instructions'* and *'a shell, in the receiver, to find a place to*

insert the advertisement in the cached content before the cached content is to be output for

display, such that the receiver receives an update for the advertisement and automatically

replaces the advertisement using the instructions', Khoo teaches that the "customized advertising

contains advertising commercials that are sequenced within the customized content in a

<u>predetermined order</u>", col. 7, lines 25-37, which is different from *'...find a place to insert the*

advertisement'.

Nevertheless Rosser, which is in the same field of customized advertising, teaches

inserting different advertisements in video programs, based upon the attached category code,

compared at least to the viewer usage profile data 120, col. 7, lines 45-58. Therefore the claimed

'shell', reads on the downstream LVIS system 46, which inserts a particular commercial within a

particular video program based on the user profile and the profile of the instant commercial. It

would have been obvious for one of ordinary skill in the art at the time the invention was made,

to modify Khoo with the feature of finding a place to insert the advertisement in the cached

content, at least for the improvement of inserting advertisements, not only in in-programming

breaks, but also in different spots, such as when the customer turns on the TV, changes channels,

or alters viewing parameters, etc., as taught by Rosser, see col. 4, lines 49-65.

Rosser also teaches that content and advertisements may be stored in the receiver device,

col. 5, lines 40-43; col. 7, lines 45-58 & col. 13, lines 14-24.

However Khoo & Rosser do not explicitly teach that the *'stored advertisements are*

updated and automatically replaced'. Nevertheless Jernigan, which is in the same field of

endeavor of customized advertising systems, teaches the claimed subject matter, col. 3, lines 18-

64.

In particular, Jernigan discloses that certain advertisements may be downloaded and

stored in a customer's TV receiving equipment. Subsequently, the stored advertisements may be

updated with new advertisement(s), col. 3, lines 18-32. It would have been obvious for one of

ordinary skill in the art at the time the invention was made, to modify the combination of Khoo

& Rosser with the feature of updating stored advertisement(s), with new advertisement(s) as

taught by Jernigan, (col. 2, lines 1-10) at least for the known desirable advantage of providing a

particular customer with different advertisements, which would for instance promote different or

newer products and/or services.

Considering claim 48, the claimed *'receiver to receive the update with a pointer, such*

that the receiver uses the pointer to store the update at a location', the *'pointer'* is broad enough

to read on the identification information used to identify the advertisements in both Rosser &

Jernigan.

Considering claims 49-50, the claimed *'marker'*, reads on the discussion in Rosser that

the insertions are placed at particular points in the video programming in order to appear

seamless, col. 7, lines 40-45; col. 13, lines 22-34 & col. 14, lines 32-67 thru col. 15, lines 1-6.

Considering claim 57, Rosser discloses a set-top device 44.

3.   Claims 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khoo,

Rosser & Jernigan, further in view of Payton, (U.S. Pat # 5,790,935).

Considering claims 51-53, the instant claims are directed to storing a list of

advertisements, in order to determine whether a particular advertisement has been already stored.

However, even though Khoo discloses transmitting a list of customized media (wherein the customized list includes a list of advertising media) that is stored on a user terminal, see Abstract; col. 5, lines 35-50 & col. 8, lines 15-25, the reference does not explicitly discuss that the list is used in order to only store advertisements that have not been stored, as recited in claims 51 & 53. Nevertheless Payton, which is in the same field of customized programming, provides a teaching that local server(s) 28 (wherein there is a local server 28 for each subscriber) receives a recommended list (which corresponds with the customized media list of Khoo) but only downloads/stores those items that are not already locally stored, see col. 6, lines 1-20. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Khoo with the feature of only downloading/storing those items that are not already previously stored as taught by Payton, for the desirable benefit of avoiding duplication, thereby conserving space on the storage device.

Even though Payton does not directly discuss that the downloaded items may be advertisement, since Khoo, Rosser & Jernigan already teach this feature, the combination of Payton would teach one of ordinary skill in the art to operate the receiver device to only download/store the advertisement(s) that are not already stored, which as discussed above obviates the problem of duplication, and meets the claimed subject matter.

4.   Claims 55-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khoo, Rosser & Jernigan, further in view of Ebisawa, (U.S. PG-PUB 2004/0111317).

Considering claims 55-56, even though the combination of Khoo, Rosser & Jernigan teaches that stored advertisements may be updated, the instant references do not teach receiving information about when to update the advertisement, and updating the advertisements on a periodic basis. Nevertheless Ebisawa, which is also in the field of customized advertising, Abstract & Para [0001-0002 & 0026] discloses periodically updating stored advertisements each time a game program is executed, or alternatively, daily, monthly or whenever the receiver/game system is turned on, see Para [0033]. Since the main program in Ebisawa, which controls the game system is downloaded from a server, see Para [0008 & 0031-0032] the claimed feature of, *'receive information about when to update advertisement'* is met by the main program being received at the game system.

It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Khoo with the feature of directing the receiver system to periodically download advertisements, at least for the advantage of insuring the reception of new advertisements, on a regular basis, which avoids the use of obsolete advertisements, as discussed by Ebisawa, Para [0003].

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 47-57 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Neither the specification nor original claims included the terms of cache and shell. Further the specification does not support a cache coupled to the receiver. Where in the specification is this coupling disclosed?

Claim 51 requires an "interruption", where is this taught in the disclosure?

(10) Response to Argument

With respect to the 103 rejection of claims 47-50 & 57, as found on page 10 of the Brief, the main argument presented by the appellant is that the references, namely Jernigan, do not teach instructions for updating. Appellant asserts that, "all Jernigan does is simply plug the advertisements in. After he updates the advertisements he just plugs them in periodically...".

Appellant goes on to assert, "...There are no instructions that are received by the receiver for updating...They just receive the advertisements", emphasis added. First of all, examiner points out that claim 47 does not recite any limitation or requirement as to how or from where

the claimed 'update instructions' are received. Therefore the claimed *'receiver to receive...update instructions'* is broad enough to read on the TV receiver (i.e., the microcontroller 16) in Jernigan simply receiving update instructions (i.e., operating instructions) from its memory. For instance, there is nothing in claim 47 that requires that the *'update instructions'* are received over a telecommunications link or from any particular network.

Therefore, the claim is broad enough to read on the update instructions being received from local memory. To that point, Jernigan teaches that the "microcontroller 16 which, in conjunction with a program stored in program memory 18, determines when and which one of the various advertisements are to be displayed", col. 2, lines 48-53. As a further explanation, Jernigan at col. 3, lines 19-25, discloses "...a graphics update interface 30 is also coupled to the data bus 14 for providing update data to be written into PROM 28 under the control of the microcontroller 16.". Hence, it is clear that the microcontroller 16 controls the update operation in Jernigan and that the program (i.e., instructions which controls the microcontroller 16) that are stored in program memory 18 are received by the instant microcontroller 16. Thus the combination of references does in fact meet the claimed subject matter, of a 'receiver to receive... update instructions'.

Furthermore, since the instructions in Jernigan are in the ROM, whenever the ROM was attached to the receiver, the receiver would have, at least at *that* time, received the update instructions.

Jernigan (col. 3, lines 19-32) clearly discloses that the "the ability to update
advertisements is provided…The arrangement includes a programmable read-only memory
PROM 28 which is also coupled to the data bus 14…A graphics **update interface** is also
coupled to the data bus 14 **for providing update data** to be written into PROM 28 **under the
control of the micro-controller 16**…", emphasis added.

Furthermore, Jernigan (col. 2, lines 45-60) teaches "…This ROM 12 is connected by a
data bus 14 to a **micro-controller 16** which, in conjunction with a program stored in program
memory 18…**determines when and which advertisements are to be displayed**", emphasis
added.

Thus, even if Jernigan merely "plugs them in periodically", as asserted by appellant, the
specifics of when and where to periodically plug them in is determined and executed by the
micro-controller 16, based on a program (which reads on the claimed *'update instructions'*)
received from program memory 18, and thus meets the claimed subject matter.

As for the claimed *'receiving…update instructions'*, the program that is within program
memory 18, is necessarily received by the program memory 18. Even though Jernigan does not
discuss how or when the program is received by the program memory 18, as pointed above,
claim 47 does not recite any limitations or requirements as to the nature of this 'receiving'.

As part of appellant's second argument, appellant cites a portion of the Board's Decision

on Appeal No. 2007-0721, which was decided based on different grounds of rejection to the

case. Appellant asserts that "The importance of this limitation is explained in the Decision on

Appeal at page 3. There, it is explained that the instruction indicates <u>when</u> to perform the

updating operation", emphasis added. Appellant goes on to additionally assert, "the Board notes

that the specification distinguishes updated advertisements from an entirely new replacement

advertisement". Thus, appellant argues on page 10 of the Brief, "Jernigan merely teaches

replacing the existing advertisements with replacement advertisements".

It appears that appellant is arguing that the updating procedure in Jernigan does not read

on the claimed subject matter. Examiner respectfully disagrees. First of all, a careful reading of

the Board's Decision on Appeal 2007-0721, finds that on page 3 of the Decision, it is stated,

"The term 'update instructions' **is not defined** in the Specification *but appears* to include an

instruction indicating <u>when</u> to perform an updating operation. See id. at 6:20-23", emphasis

added.

Thus, in this instance, the Board is providing an explanation of a possible operation of the

'update instructions'. Second, notwithstanding this discussion, and appellant's citation of the

Board's explanation, it is pointed that the claim at issue does not recite any language directed to

this portion of the Specification as to <u>when</u> the updating operation is performed. In particular, the

portion of the Specification cited by the Board's Decision on Appeal 2007-0721, (page 6, lines

20-23) discloses, "For example, in accordance with one embodiment, at predetermined times, all

of the stored commercials may be automatically updated in accordance with the stored update instructions". Claim 47 does not recite anything having to do with automatically updating the commercials at predetermined times. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, this argument cited by appellant concerning <u>when</u> the updating operation is performed, as discussed in the Board's decision, is a moot point.

Furthermore, in the Board's Decision on Appeal 2007-0721, it was also pointed that in appellant's specification, that "in other embodiments, the stored advertisement may be replaced with another advertisement that does not constitute an update", see page 9, lines 20-24. Notwithstanding this disclosure, col. 3, lines 19-32 of Jernigan uses the language, that the invention has the ability to "<u>update the advertisements</u>...the graphics update interface includes a data input 32 for <u>receiving the data updates</u> which may be provided through data port in the TV receiver connected to telephone lines, CATV services or other broadcast data services.", emphasis added.

Thus, from the plain language used in Jernigan, the stored advertisements are updated, as is recited in appellant's claim. The update language used Jernigan would encompass a new version of the same advertisement or a new advertisement altogether. Furthermore, as pointed out above, the advertisement(s) are selectively displayed. The selective display of the advertisements in Jernigan, require instructions for doing so.

Moreover, to the extent that appellant argues that Jernigan does not explicitly teach that the updated advertisements are not necessarily related to the already stored advertisements, and thus may be considered replacement advertisements, examiner points out that this distinction in the claim is an obvious modification of Jernigan, as covered under the KSR rules. In particular, appellant argues, "Jernigan merely teaches replacing the existing advertisements with entirely new advertisements". First of all, examiner respectfully disagrees with this characterization of Jernigan. Jernigan at col. 2, lines 5-10, states, "The invention also contemplates <u>the ability to update the contents of the advertisement memory</u> such that new advertisements may be stored at a later date. The data representing these new advertisements may be sent to the TV receiver over telephone lines, CATV service lines, broadcast data services, etc.", emphasis added. However, this passage of Jernigan is silent as to whether or not these updated advertisements, i.e., new advertisements are replacements of existing advertisement(s) or totally new advertisement(s) unrelated to the advertisement(s) they replace, as discussed in appellant's specification page 10, lines 15-20. Nevertheless, it is incorrect for appellant to assume either way.

Appellant does not claim creating the updated advertisements, but rather the *'receiver to receive an update for said advertisement...'*. Thus, the question at hand is whether the receiver in Jernigan receives updated advertisements or only replacement advertisements. The answer to this query is that as far as the receiver knows, there is no difference, since an updated advertisement, may just mean that for example, a particular item in the existing advertisement has been airbrushed out of the shot; or maybe that the advertisement itself has been shortened; or elongated; or that one of the actors have been changed, or that the voice over has been changed; or that a graphic or text has been added or deleted. All of these modifications represent changes/updates to a video image (advertisement), but do not change the nature of the video itself. As one of ordinary skill in the art would readily recognize, appellant has not recited any patentable difference between an updated advertisement or a replacement advertisement, that is unrelated to the original advertisement, it is simple a matter of content. There new advertisements in Jernigan are referred to as updated advertisements, and as such read on the claimed subject matter.

As pointed out though in the previous paragraph under the new KSR rules, based on the decision of KSR International Co. v. Teleflex Inc., et al, it has been established that a 103 obviousness rejection may be sustained in view of one or more of the following rationales being evident in the rejection. (1) Combining prior art elements according to known methods to yield predictable results. (2) Simple substitution of one known element for another to obtain predictable results. (3) Use of known techniques to improve similar devices (methods or

products) in the same way. (4) Applying a known technique to a known device (method or

product) ready for improvement to yield predictable results.

Therefore, as discussed above the rejection using the combination of Jernigan could be

sustained at least using rationales (3) & (4). In particular, even if one were to argue that since

Jernigan does not explicitly discuss whether the updated/new advertisements are new and

unrelated to the existing advertisements or updates to existing advertisements, according to

appellant's spec. page 10, lines 15-20; the technique of modifying, i.e., updating existing video

images, including advertisements was old in the art and represents a known technique to improve

a similar device, or alternatively, applying a known technique to a known device or product for

improvement that achieves predictable results. Therefore, under at least (3) & (4) of the new

KSR rules, even if for the sake of argument, the combination including Jernigan did not meet the

claimed language of *'update for advertisements'*, as construed by page 10, lines 15-20 of the

specification, there exists at least two valid rationales for modifying the combination of

references, including Jernigan, which meet the claimed subject matter.

Furthermore, to the extent that appellant would argue that the claimed *'update*

instructions' would treat an updated advertisement different from a new unrelated advertisement,

(which could be a point of novelty) there is no such requirement found in the disclosure. As

pointed out above, the disclosure does not define the claimed *'update instructions'*, therefore

according to standard examining practice, the limitation should be read with its broadest

reasonable interpretation. Thus, examiner should not presume that the *'update instructions'* treat

an advertisement that is an update of an existing advertisement any differently from an

advertisement that is new and unrelated to the original advertisement. In fact, the specification

mentions both of them as replacement advertisements or new advertisements, see page 10, lines

12-14.

    Finally, examiner points out that even if the advertisement updating procedure in

Jernigan is construed to not read the updating as understood by appellant's Specification, it is

noted that Jernigan clearly teaches another embodiment that enables customers to add graphics

(that represent certain announcements) to the local system for storage, col. 3, lines 31-45. The

locally stored graphic updates may be added to the advertisements that were already stored and

displayed along with the advertisement. Thus, Jernigan provides a completely different method

of updating advertisement according to update instructions, and replacing the existing

advertisement display by showing the new advertisement, which includes the locally generated

graphic updates.

    With respect to the 112, 1st paragraph rejection, appellant's only response is that "the

exact same words do not need to be used in the specification and the claims". It is argued that

this "is the sole and total basis" for the written description rejection. Examiner respectfully

disagrees.

Page 7 of appellant's brief serves as an explanation for the terms cache & shell. While the

memory 8 & 30 does seem to explain the existence of the cache to store content &

advertisement, the processor being pointed to as the shell still does meet the written description

test.

Furthermore, with respect to claim 51, appellant has not shown any interruption of

content. Indeed the specification disclose that both content & advertisements may be stored and

that advertisements may be inserted into content, but this does not necessarily amount to an

interruption as recited in claim 51.

(11) Related Proceeding(s) Appendix

The following are the related appeals, interferences, and judicial proceedings known to

the examiner which may be related to, directly affect or be directly affected by or have a bearing

on the Board's decision in the pending appeal:

Appeal No. 2007-0721, decided March 7, 2008 for this application.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Conferees:

/Reuben M. Brown/
Patent Examiner, Art Unit 2424

Chris Kelley   Chris Grant

/Christopher Kelley/

Supervisory Patent Examiner, Art Unit 2424

/Christopher Grant/

TQAS, TC 2400